

REMARKS

Claims 36-74 are pending. Claims 1-35 have been cancelled. Claims 36, 47, and 68 are independent. Claims 36, 43, 47, and 52 have been amended and claims 56-74 have been added by this amendment. In view of the present amendments and remarks, reconsideration and allowance of this application are respectfully requested.

35 U.S.C. § 103(a) Schindler/Porter/AAPA Rejection

Claims 36-43 and 47-52 were rejected under 35 U.S.C. § 103(a) as being obvious over Schindler (U.S. Patent No. 6,081,830) in view of Porter (U.S. Patent No. 6,434,599) and further in view of "Applicant Admitted Prior Art (AAPA)." This rejection is obviated by the present amendment to independent claims 36 and 47.

Claim 36 is directed to providing a buddy list to a network user and recites, among other things, determining television programming selected for viewing by a network user, "accessing two or more user-defined lists of other users for whom presence is monitored," and "selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming." Each of the two or more user-defined lists includes members defined by the network user. It is respectfully submitted that Schindler does not describe or suggest at least these features of claim 36.

By contrast, Schindler uses the identity of a television channel as a basis for identifying and automatically linking to a computer chat room. Stated differently, the point of Schindler is to identify and link to chat rooms that correspond to the content presently tuned by a television.¹

¹ Fig. 3 of Schindler shows a computer, a display screen 38 that includes a TV program area 40, a chat room identification area 44, with a participant area 46 that lists names of users participating in the chat room, and a chat entry area 52 in which chat messages are displayed. The display screen 38 also includes a "TV controls area 42" with "on-screen buttons" that allow a user to change the channel of the TV programming displayed in TV program area 40. According to Schindler, a computer detects a user's television channel, and determines an ID code associated with the channel. The ID code is sent to a server 20 and the server 20 selects a chat room for the user corresponding to the ID code (See Fig. 2 and col. 6, ll. 26-43). The chat room is run by the server 20 and corresponds to TV programming (See, col. 4, ll. 53-65). Messages may be exchanged between participants in the chat room.

Applicant : Carlos Silva et al.
Serial No. : 09/475,391
Filed : December 30, 1999
Page : 10 of 12

Attorney's Docket No.: 06975-048001 /AOLTV 07

Schindler does not, however, describe accessing two or more user-defined lists of other users for whom presence is monitored and selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming.²

Porter does not remedy the deficiencies of Schindler noted above with respect to claim 36. Porter describes dynamic formation of a chat session facilitated by an information site or a third party chat server. However, Porter fails to contemplate accessing two or more user-defined lists of other users for whom presence is monitored and selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming, as recited in claim 36.

AAPA also fails to remedy the deficiencies of Schindler and Porter noted above with respect to claim 36. AAPA (page 3, lines 12-18 of the instant application) teaches creation of a pre-defined buddy list. However, AAPA does not contemplate accessing two or more user-defined lists of other users for whom presence is monitored and selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming.

Moreover, AAPA is incompatible with the chat art of Schindler and Porter. AAPA monitors the presence of a single, user-defined group of other users selected by a user. By contrast, the chat art of Schindler and Porter does not monitor the presence of a single, user-defined list of other users. Instead, the chat art of Schindler and Porter displays a list of the network users who are currently participating in a chat room. In the chat context, the list is not user-defined. Rather, other network users are free to join and leave the chat room at will, and the list will be updated accordingly. A user has no control over the appearance of other users in the list of users participating in the chat room. In sum, a user-defined user list does not make sense in a chat environment and is not compatible with a list of network users currently participating in a chat room.

² It is acknowledged at page 3 of the Office Action that, "Schindler does not teach selecting a buddy list based on television programming."

Thus, the proposed combination of Schindler, Porter, and AAPA does not establish a *prima facie* case of obviousness with regard to claim 36. Therefore, reconsideration and withdrawal of the rejection of claim 36, and dependent claims 37-43 are respectfully requested.

Claim 47 recites, similarly to claim 36 and among other things, a computer program with instructions to cause a processor to "access two or more user-defined lists of other users for whom presence is monitored" and to "select an initial buddy list from among two or more user-defined lists based upon the determined television programming." As discussed above with respect to claim 36, Schindler, Porter, and AAPA, alone or in combination, do not describe or suggest at least these limitations.

Claims 48-52 depend from claim 47 and are believed to be allowable for at least the reasons given for claim 47.

It is respectfully submitted that the proposed combination of Schindler, Porter, and AAPA does not establish a *prima facie* case of obviousness with regard to claims 47-52. Therefore, reconsideration and withdrawal of the rejection of these claims are respectfully requested.

35 U.S.C. § 103(a) Schindler/Porter/AAPA/DeSimone Rejection

Claims 44-46 and 53-55 were rejected under 35 U.S.C. § 103(a) as being obvious over Schindler in view of Porter, AAPA, and DeSimone (U.S. Patent No. 6,212,548). This rejection is obviated by the present amendment.

Claims 44-46 and 53-55 depend from one of claims 36 and 47 and are believed to be allowable for at least the reasons given above for claims 36 and 47. In particular, DeSimone does not remedy any of the deficiencies of Schindler, Porter, and AAPA that are noted above with respect to claims 36 and 47. As such, it is respectfully submitted that Schindler, Porter, AAPA and DeSimone, alone or in combination, do not establish a *prima facie* case of obviousness with regard to claims 44-46 and 53-55.

Therefore, reconsideration and withdrawal of the rejection of these claims are respectfully requested.


Applicant : Carlos Silva et al.
Serial No. : 09/475,391
Filed : December 30, 1999
Page : 12 of 12

Attorney's Docket No.: 06975-048001 /AOLTV 07

Enclosed is a \$72.00 check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: February 20, 2004



Scott R. Boalick
Reg. No. 42,337

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331